

REMARKS

Claims 11-14 were pending in the application as of the previous office action. Claims 11-14 remain pending in the application. Although not specifically noted in the Office Action dated 04/04/06, since the office action followed applicant's notice of appeal, the effect of the Office Action is to re-open prosecution. Applicant hereby elects to respond to the Office Action pursuant to 37 C.F.R. § 1.111 as opposed to requesting reinstatement of the Appeal.

Claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being obvious considering U.S. Patent No. 6,899,638 to Itawa. Applicant respectfully traverses the rejection on the grounds that the Examiner continues to misread the Itawa reference and/or continues to read the Itawa reference for more than it shows. It is well settled that a prior art reference cannot be relied upon for more than it would have reasonably suggested to one having ordinary skill in the art. Merck & Co. v. Biocraft Laboratories, 874 F.2d. 804 (Fed. Cir. 1989); W.L. Gore & Associates v. Garlock, Inc., 712 F.2d 1540 (Fed. Cir. 1983).

The Examiner states that Itawa shows a faceplate in which the major and minor axes of the central thickened region are 10mm and 5mm respectively, and the major and minor axes of the transition region (tapered region) are 15mm and 10mm respectively. In support of this, the Examiner relies on the language in Column 14 reproduced below.

FIG. 8 shows the structure of a number 1 wood according to the present invention. Also in this example, a head 1 of the wood has an elliptic flexural range and a sweet spot 15 matched with the center (central hitting point) 8 of ellipses 16 and 17.

The major axes 7 of the ellipses 16 and 17 are inclined by 5° with respect to an X-axis. The ellipse 16 has a major axis of 10 mm and a minor axis of 5 mm (area: 157 mm^2), and a center part 12 has a thickness of 2.4 mm.

The ellipse 17 has a major axis of 25 mm and a minor axis of 15 mm. The thickness of a peripheral region 14 located around the ellipse 17 is 2.1 mm. The thickness of a tapered part 13 is gradually reduced toward the peripheral portion thereof. Table 7 shows an exemplary thickness distribution of a face 2 in the example shown in FIG. 8.

TABLE 7

Position of Major axis of Central Ellipse (mm)	Position of Minor axis of Central Ellipse (mm)	Thickness
0-10	0-5	2.4 mm
10-15	5-10	Tapered 0.3/5
15-to Periphery	10-to Periphery	2.1 mm

As can be discerned from the above language, although the Examiner is correct that the major and minor axes of the central region are 10mm and 5mm, lines 12-14 clearly state that the major and minor axes of the transition region are 25mm and 15mm, respectively, not 15mm and 10mm as stated by the Examiner. The Examiner's reliance on Table 7 is misplaced, since Table 7 states that is a plot of axis position (not length) which, if interpreted as the Examiner states, is inconsistent with the clear statement in the preceding sentence that major and minor axes are 25mm and 15mm. Moreover, nothing in Itawa discloses or suggests that the entire perimeter of the tapered

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region is a fixed amount greater than the perimeter of the raised portion since Itawa does not disclose that the face plate is manufactured in the unique manner of the present invention.

The Examiner also takes the position that the limitation contained in claims 11-14 that the second major axis is equal to the first major axis plus a predetermined distance and the second minor axis is equal to the first minor axis plus said predetermined distance does not result in any surprising performance improvement over the club disclosed in Itawa. The Examiner then takes the position that since the unique structure of the face plate claimed in claims 11-14 is dictated by the unique manufacturing method and has no "unexpected" performance improvement, the limitation is an obvious matter of design choice.

Applicant believes the Examiner is mixing the standard for statutory subject matter under §101 with the standard for patentability under §103 and/or takes too narrow a view of what is and is not a non-obvious improvement. A structure that performs equally well to the prior art but is significantly easier and less costly to manufacture is just as useful as a structure that costs as much (or more) as the prior art but has improved performance. Therefore, the invention claimed in claims 11-14 clearly meets the test under §101 that an invention be "useful." Moreover, there is no requirement under §103 that an invention perform better than the prior art. Under the test articulated in *Graham v. John Deere*, 383 U.S. 1 (1966), the focus should not be on whether the performance of the claimed invention is "unexpected." The focus should be whether the reference, when viewed without the benefit of impermissible hindsight vision, truly suggests the invention claimed in the present application. In this case, since Itawa does not disclose or suggest the unique manufacturing method disclosed in the present invention, nothing in Itawa suggests the particular structure claimed in claims 11-14. Accordingly, there is no support in Itawa for the examiner's

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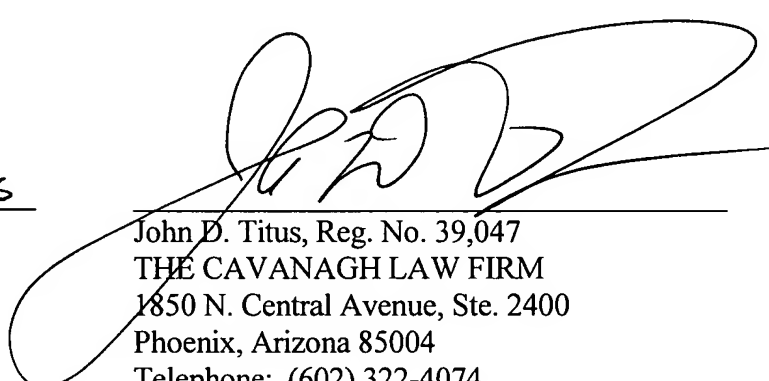
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position that Itawa renders the invention claimed in claims 11-14 obvious and, therefore, the rejection should be withdrawn.

Conclusion

No new matter is introduced by the amendments herein. Based on the foregoing, applicants believe that all claims under consideration are in a condition for allowance and reconsideration of this application is respectfully requested.

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